

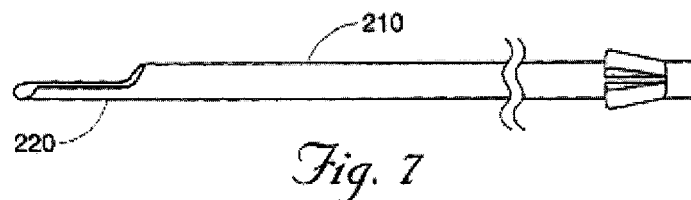
### III. Remarks

#### A. Status of the Application

Claims 1, 4, 12, 23, and 24 are pending, of which, claim 1 is in independent form. By this paper, claim 24 is amended. Reconsideration of the presently pending claims is respectfully requested in light of the above amendment and the following remarks.

#### B. Drawings

The Final Office Action objected to the drawings under 37 CFR 1.83(a). In particular, the Final Office Action stated that “the side surface of the platform recited in claim 1 must be shown.” Final Office Action, p.2. Applicants respectfully submit that at least FIG. 7, reproduced below, of the present application discloses the claimed side surface of the platform.



As shown in FIG. 7 and described by the present application, “platform 220 comprises a semi-cylindrical section which extends from the walls of the hollow member 210.” Published Present Application, para. [0065]. In that regard, by way of example, the top side surface of the semi-cylindrical section of platform 220 can be considered as corresponding to the claimed side surface of the platform. Accordingly, the drawings comply with 37 CFR 1.83(a) by showing every feature of the invention specified in the claims. Therefore, Applicants respectfully request the Examiner to withdraw the objection to the drawings.

#### C. Claim Rejections – 35 U.S.C. §112

##### *1. First Paragraph Rejections*

The Final Office Action rejected claim 1 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Final Office Action stated “there is no disclosure support for claimed a platform **that is open in a radial direction and has a side surface in the radial direction.**” Final Office Action, p.3. Applicants respectfully

submit that the application fully supports the claim 1 recitation of “a platform that is open in a radial direction and has a side surface facing in the radial direction.” At least FIG. 7, shown above, of the present application discloses these claimed features. Accordingly, Applicants respectfully request that the Examiner withdraw the §112 rejection of claim 1.

Additionally, the Final Office Action rejected claim 24 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. By this paper, claim 24 has been amended to recite “wherein the extension protrudes from the distal end of the hollow body from only a circumferential portion of the circumferential wall of the hollow body.” At least FIG. 7, shown above, of the present application discloses these claimed features. Accordingly, Applicants respectfully request that the Examiner withdraw this §112 rejection of claim 24.

## *2. Second Paragraph Rejections*

The Final Office Action rejected claim 24 under 35 U.S.C. §112, second paragraph, because the term “relative small” renders the claim indefinite. Final Office Action, p.4. By this paper, claim 24 has been amended to recite “wherein the extension protrudes from the distal end of the hollow body from only a circumferential portion of the circumferential wall of the hollow body.” At least FIG. 7, shown above, of the present application discloses these claimed features. Accordingly, Applicants respectfully request that the Examiner withdraw this §112 rejection of claim 24.

## **D. Claim Rejections – 35 U.S.C. §102**

The Office Action rejected claims 1, 2, 4, 12, and 24 under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2002/0010472 to Kuslich et al. (“Kuslich”). The rejection of claim 2 is moot in light of this claim being previously canceled. Applicants respectfully traverse the rejection with respect to the pending claims.

Applicants respectfully submit that Kuslich does not constitute prior art to the present application. In that regard, Kuslich was filed December 15, 2000 and is a continuation-in-part of U.S. Application No. 09/608,079 filed June 30, 2000. Even assuming *arguendo* that the portions of Kuslich relied on by the Final Office Action are supported by the continuation-in-part of U.S. Application No. 09/608,079, the present application is entitled to an earlier filing date of April 7, 2000, by claiming priority to U.S. Provisional Application No. 60/195,207 (“the provisional

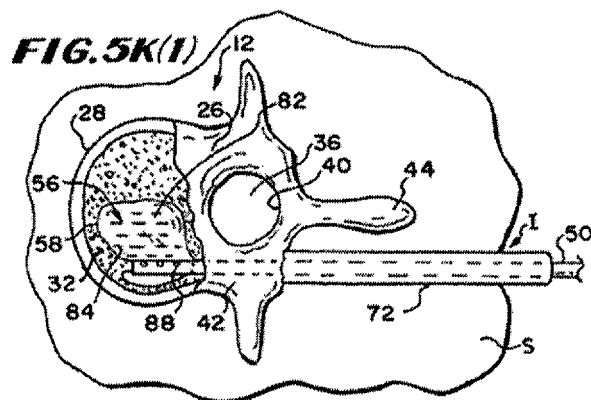
application”). The pending claims of the present application are at least supported by FIGS. 2, 7, and 28 and pages 11-12 of the provisional application. Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection and pass claims 1, 4, 12, and 24 to allowance.

**E. Claim Rejections - 35 USC § 103**

The Final Office Action rejected independent claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,248,110 to Reiley et al. (“Reiley”). Applicants respectfully traverse the rejection on the grounds that the cited reference is defective in establishing a *prima facie* case of obviousness.

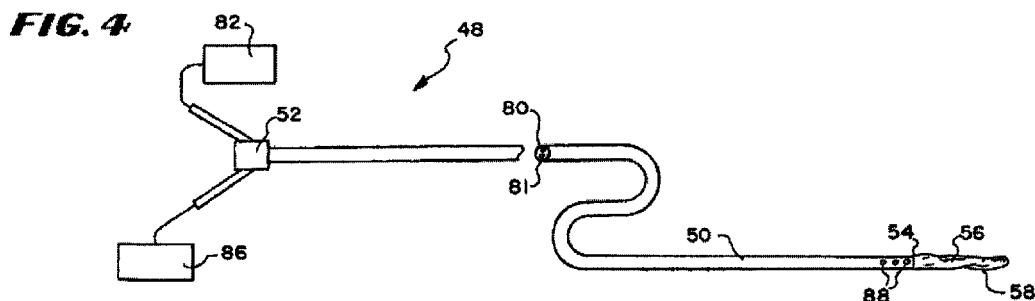
With respect to independent claim 1, Reiley does not disclose or suggest the applicants’ claimed method step of “providing a tool comprising a hollow body including a circumferential wall having a distal end, the tool also comprising an extension that protrudes from the circumferential wall beyond the distal end and forms a platform that is open in a radial direction and has a side surface facing in the radial direction,” “positioning the platform near the expandable structure, with the side surface of the platform located between the expandable structure and a first region of the cancellous bone which is not to be compressed,” and “forming a cavity in a second region of cancellous bone by expanding the expandable structure against the side surface of the platform with the platform serving as a barrier to induce the expandable structure to expand radially away from the side surface of the platform to compress the second region of the cancellous bone, while the first region of the cancellous bone remains substantially uncompressed.”

Reiley simply does not teach or suggest the applicants’ claimed method. The Final Office Action cites to FIG. 5K(1), reproduced below, in an attempt to meet the limitations of the applicants’ claims.



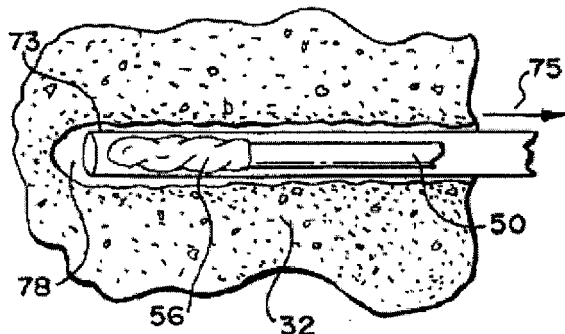
The Office Action analogizes a distal end portion of the Reiley catheter tube 50 (namely, the longitudinal portion disposed inwardly of the distal catheter tube end 54 with the suction holes 88 therein as shown in FIG. 4) to applicants' claimed platform.

However, one skilled in the art would recognize that the Office's interpretation of FIG. 5K(1) is inconsistent with Reiley's disclosed method. In that regard, Reiley discloses that the catheter tube 50 shown in FIG. 5K(1) is also shown in FIG. 4. *See* Reiley, col.8 ll.21-35. As can be seen in this exemplary device of FIG. 4, Reiley discloses that, in this embodiment, **the balloon 56 is secured to and extends axially away from the distal end 54 of the catheter tube 50.**

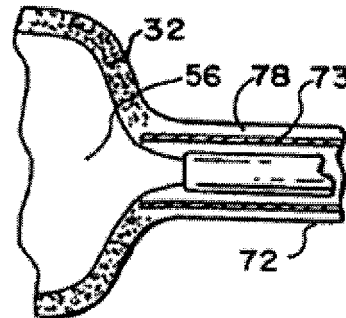


Furthermore, as shown below in FIGS. 5J(2), and 5K(2)—which are part of the same method sequence disclosed by Reiley that involves FIG. 5K(1)—**the balloon 56 is again shown in an example as being secured to and extending axially away from the distal end 54 of the catheter tube 50.**

**FIG. 5J(2)**



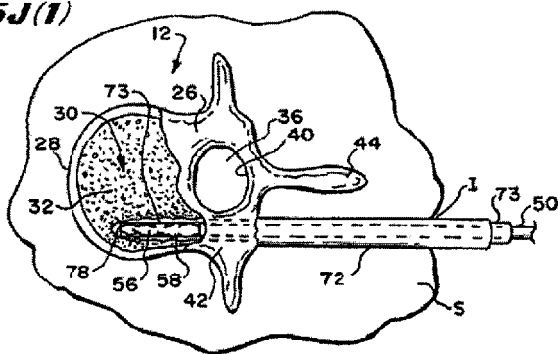
**FIG. 5K(2)**



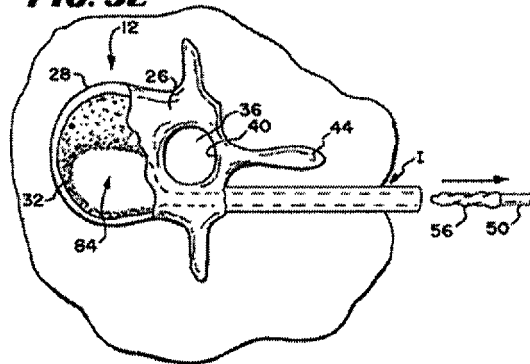
Thus, this example in Reiley appears to teach the balloon 56 is secured to and extends axially away from the distal end 54 of the tube 50 and expands from the end 54 of the tube 50 as opposed to a radially facing side surface portion of a distal end portion of the tube 50 in the manner claimed. In other words, the expandable balloon member 56 does not appear to expand against any radially facing side surface portion of the distal end of the catheter tube 50 in a manner directing further expansion of the balloon radially outwardly from such side surface portion during performance of the disclosed Reiley method.

Moreover, as shown below by comparing FIGS. 5J(1) and 5L, Reiley discloses that cavity 84 is formed by compressing the cancellous bone 32 in both upward and downward directions relative to the horizontal axis of the tube 50 subsequent to the inflation of the balloon 56.

**FIG. 5J(1)**



**FIG. 5L**



In that regard, it appears that the downward cancellous bone compression depth is substantially less than the upward cancellous bone compression height because the tube 50 was initially quite close to a bottom portion (as viewed in FIGS. 5J(1) and 5L) of the cortical bone 28. In other words, there is no teaching or suggestion by Reiley of positioning the catheter tube 50 near

balloon 56, with the side surface of the catheter tube 50 located between the balloon 56 and a first region of the cancellous bone 32 which is not to be compressed and forming cavity 84 in a second region of cancellous bone 32 by expanding the balloon 56 against the side surface of the catheter tube 50 with the tube serving as a barrier to induce the balloon 56 to expand radially away from the side surface of the tube 50 to compress the second region of the cancellous bone 32, while the first region of the cancellous bone 32 remains substantially uncompressed, in the same manner as recited in claim 1.

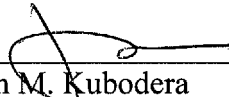
Accordingly, Reiley does not teach or suggest all of the recited features of claim 1. Claims 4, 12, 23, and 24 depend from and add additional features to claim 1. Thus, claims 4, 12, 23, and 24 are allowable for at least the same reasons as discussed above for claim 1. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw the rejection and pass claims 1, 4, 12, 23, and 24 to allowance.

#### **IV. Conclusion**

In view of the foregoing remarks, all of the claims currently pending in this application are in a condition for allowance. A telephone interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

The Final Office Action contains characterizations of the claims and the related art of which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Final Office Action.

Respectfully submitted,

  
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